

REMARKS

In the Office Action that was mailed on December 15, 2004, claims 1-15, 17-22, 30-33, 35-36, 39, 41-42, and 45-49 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; 1-29 and 31-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Chandra, Nesbitt, Adachi, Hussey, Kaji, Kay, Larson, McFiggins, Gu, Gabber, Mann, Evans, Ganesan, and DeRoest. The foregoing rejections are respectfully traversed.

Claims 1-51 are pending in the subject application, of which claims 1, 16, 17, 23, 24, 30, 31, and 47-51 are independent claims.

Amendments to the Claims:

Claims 47-49 are amended herein to remove 'steps of' language to make it clear that such claims are not intended to invoke section 112, paragraph 6. Claim 30 is amended herein to delete "implemented in a computing environment" from the preamble. Claims 47-49 are also amended herein to recite "receiving a requested account name from a user". Support for such amendments may be found in the Specification, for example, at page 8, lines 13-14. Claims 1, 17, 30, 31, and 47-49 are amended herein to recite "in a computing environment" in the body of the claims. Care has been exercised to avoid the introduction of new matter.

Allowable Subject Matter:

In item 25, on page 32 of the Office Action, the examiner indicated that claim 30 would be allowable if rewritten to overcome the rejection under section 101. Claim 30 is amended herein (see discussion thereof below), and the Applicants respectfully request that the examiner allow claim 30 (as amended).

Rejections of the Claims:

Rejections Under 35 U.S.C. § 101:

Claims 1, 17, 30, 31, and 47-49 are amended herein to recite "in a computing environment" in the body of the claim. Claims 2-15, 18-22, 32-33, 35-36, 39, 41-42, and 45-46 depend, directly or indirectly, from claims 1 or 17.

All of the claims rejected under section 101 now recite an implementation in a computing environment

in the body of the claims. In addition, all of the claims rejected under section 101 are statutory under the second safe harbor provision discussed above, because they recite the measurement of physical activities (e.g., the user's request) to be transformed into computer data (e.g., input) where the process causes a physical transformation (e.g., providing an account name to the user). The Applicants respectfully assert that claims 1-15, 17-22, 30-33, 35-36, 39, 41-42, and 45-49 recite statutory subject matter. The Applicants respectfully request that the examiner withdraw the rejections under section 101.

Rejections Under 35 U.S.C. § 103(a):

Differences Between the Cited References and the Claimed Invention:

Independent Claims 1, 16, 17, 23, 24, and 47-51:

Independent claims 1 and 16 recite "combining the word element and at least a stem of the requested account name to produce a modified account name." Independent claims 17, 23, and 49 recite "combining the first and second word elements to produce a random account name." Independent claim 24 recites "combining the word elements with at least a stem of the requested account name to produce modified account names." Independent claims 47-48 recite "combining the word element and the requested account name to produce a modified account name." Independent claims 50-51 recite "combining the word elements with the requested account name to produce modified account names."

Nesbitt was added in the present Office Action and was used to reject all of the independent claims. Specifically, Nesbitt was cited in the Office Action to support the examiner's assertion of

well-known web email site functionality, where when the user tries to sign up by inputting a user-id, the system checks to see if the user-id is already taken. If it is already taken, the system presents the user with a list of suggested user-ids that have been combined with your original id and an arbitrary number(s) or word(s). For example, if someone tries to sign up as steve@hotmail.com, it will suggest, steve0527, steve2004, etc. to create a unique ID.

(Office Action, p. 6, 16, 19-21, 25, 29, 31-32). It appears that the examiner is relying on Nesbitt to anticipate the combination of (1) a word element with at least a stem of a requested account name, (2) first and second word elements, and (3) a word element with a requested account name, as recited in independent claims 1, 16, 17, 23, 24, and 47-51 (discussed above).

In the section of Nesbitt that discusses Web e-mail account creation, which was cited in the Office

Action, Nesbitt states that “[i]f you try to use a name that’s already been taken, most services will offer you a list of alternatives. When I created an account for this article, I typed ‘scottnesbitt’ as my user name. One service gave me several substitutes, including ‘snesbitt’ and ‘scottn.’” (Nesbitt, p. 1). However, both suggested substitutes in Nesbitt are based solely on the requested user name. Specifically, “snesbitt” takes the first letter of the requested user name (“s”) and combines it with the last six letters of the requested user name (“nesbitt”). Similarly, “scottn” simply uses the first six letters of the requested user name. While alternative user names are suggested, they are based entirely on the requested user name. Nesbitt does not disclose or suggest otherwise.

In contrast to Nesbitt, claims 1, 16, 17, 23, 24, and 47-51 of the subject application are not restricted to working with only the requested user name. Claims 1, 16, and 24 recite combining the word element and at least a stem of the requested account name. Claims 17, 23, and 49 recite combining the first and second word elements. Claims 47-51 recite combining the word element and the requested account name. Therefore, claims 1, 16, 17, 23, 24, and 47-51 of the subject application are patentably distinguishable over the cited references because the cited references do not anticipate combining the word element and at least a stem of the requested account name, combining the first and second word elements, or combining the word element and the requested account name. The Applicants respectfully request that the examiner withdraw the rejections and allow those claims.

Independent Claim 31:

Claim 31 recites “providing without any input or suggestion of names from the user, a list of multiple alternate unique account names.” In rejecting claim 31, the Office Action concedes that Kay and Evans do not disclose the account name. However, the Office Action asserts that it would have been obvious to combine Kay and Evans with Nesbitt to get the account name.

As discussed above, Nesbitt only works with a requested account name to suggest an alternative account name. However, claim 31 does not recite receiving any requested account name from a user. In fact, claim 31 specifically recites that no “input or suggestion of names from the user” is used in providing alternate unique account names. Clearly, Nesbitt is not relevant to the subject matter of claim 31 because Nesbitt requires a requested account name. Without Nesbitt, Kay and Evans are not sufficient to anticipate claim 31, because they admittedly lack an account name. Therefore, claim 31 is patentably distinguishable over the cited references. The Applicants respectfully request that the examiner withdraw the rejection and allow claim 31.

Continuing Lack of Support for Well-Known Conclusions:

The Applicants thank the examiner for citing a reference (Nesbitt) in response to the Applicants' request that the examiner cite a reference in support of her conclusion that the combination of an original ID and an arbitrary word is well-known in the art. However, the Applicants note that the examiner has not cited a reference in response to the Applicants' request that the examiner cite a reference in support of her conclusion that randomized seeds are created using either single or multiple digit numbers is well-known in the art. In the alternative, the examiner has not withdrawn her reliance on the latter assertion of being well-known in the art. Therefore, the Applicants respectfully remind the examiner of the duty under MPEP § 2144.03 and 37 C.F.R. § 1.104(d)(2), as discussed on pages 25-26 of the previous Amendment. The Applicants repeat their request at this time.

Continuing Lack of Support for Motivation to Combine/Modify Cited References:

On pages 24-25 of the previous Amendment, the Applicants asserted that the previous Office Action failed to properly support the motivation to combine/modify the cited references. The present Office Action repeats many of the same combinations and modifications without any elaboration or response to the Applicants' arguments. In addition, the present Office Action again adds new references in combination with the previously cited references without property supporting the motivation to combine/modify the newly cited references. The Applicants repeat their arguments herein and request that the examiner either respond to the Applicants' arguments or withdraw the rejections.

Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any

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additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-2112.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Matthew Q. Ammon', written over the closing text.

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